Patent 030727.0035.UTL1

IN THE UNITED STATES PATENT AND TRADEMARK OFFIC

Applicants: Erion et al.

Serial No.: 09/657,919

September 8, 2000

Title: PRODRUĞS FOR LIVER SPEC DRUG DELIVERY

Group Art Unit: -1623

Examiner: J.O. Wilson

Commissioner for Patents Washington, D.C. 20231

PETITION FOR EXTENSION OF TIME

MENDMENT AND RESPONSE

Dear Sir:

This communication is in response to the Office Action mailed on September 16, 2002 Applicants hereby petition for a three-month extension of time in which to respond to the Office Action mailed on September 16, 2002. With the granting of the foregoing Petition, the time for responding to this Office Action is extended to include March 17, 2003, because March 16, 2003, falls on a Sunday. The Commissioner is hereby authorized to charge trust account No. 50-2613 for the three-month extension fee due herein, and any other fees that may become due or credit become payable during the pendency of this application.

CERTIFICATE OF TRANSMISSION .

I hereby certify that this paper (along with anything referred to as being attached or enclosed) is being facsimile transmitted to the United States Palent and Trademark Office, Fax No. (703) 872-9305 on the date shown below.

March 4, 2003

Date of Transmission

Signature of Person Transmitting Paper

Received from < 858 720 2555 > at 3/4/03 7:10:42 PM [Eastern Standard Time]

Paul, Hastings, Janofsky & Walker LLP 12390 El Camino Real, San Diego, CA 92130 telephofie 858-720-2500 / facsimile 858-720-2555 / www.paulhastings.com

Paul *Hastings*

facsimile:

(858) 720-2555 Diana L. Bush, Ph.D

lèphone:

(858) 720-2885

ĐLB4

client name: METABASIS

_date: March 4, 2003

client matter numb**ë**r:

.0035.UTL

pages (with cover):

to:

Re:

comments:

company/office:

facsimile:

= telephone:

Examiner James O. Wilson

USPTO"

(703) 872-9306 ___ (703) 308-4624

Art Unit 1623

FAX RECEIVED

MAR 5 2003.

U.S. Patent Application Ser. No. 09/657,919

Filed 09/08/2000

PRODRUGS FOR LIVER SPECIFIC DRUG DELIVER

Our Ref: 030737.0035.UTL

GROUP 1600

Please see attached, our Response to Office Action mailed 9/20/2002.

NOWLEDGE RECEIPT BY RETURN FACSIMILE

If you do not receive all pages, please call immediately Facsimile Center: (858) 720-2500 11.

This message is intended only for the use of the individual or entity to which it is addressed; and may contain information that is adversed, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication is strictly prohibited. error, please notify us immediately by telephone, and return the original massage totus at the above address via the U.S. Posta. Service. Thank you.

sid.

Response to Restriction Requirement Serial No. 09/657,919 Page 2 of 12 7039 Patent 030727.0035.UTL

AMENDMENTS

In the claims:

Please cancel claims 50-64, 89-103, and 119-154 without prejudice. The Applicants reserve the right to pursue claims to non-elected inventions in a Divisional application.

In the specification:

Please amend the paragraph at p. 34, lines 6-15 to read:

Various kinds of parent drugs can benefit from the prodrug methodology of the present invention. It is preferred that the prodrug phosph(oramid)ate moiety be attached to a hydroxy, amine, or thiol on the parent drug. In many cases the parent drug will have many such functional groups. The preferred group selected for attachment of the prodrug is the group that is most important for biological activity and is chemically suitable for attachment of the prodrug moiety. Thus, the phosph(oramid)ate moiety will prevent the prodrug from having biological activity. An inactive prodrug should limit systemic side effects because higher drug concentrations will be in the target organ (liver) relative to non-hepatic tissues. The amine should have at least one N-H bond, and preferably two.

REMARKS

Claims 1-158 are pending. The Examiner has withdrawn claims 50-64, 89-103, and 119154 from consideration as directed to non-elected inventions. Claims 4-49, 65-88, 104-118, and 155-158 stand rejected.

The Applicants respectfully note that claims 1-49, 65-88, 104-118, and 155-158 are the correct claims and not claims 1-49, 65-87, 104-118, and 155-158, as indicated by the Examiner on the Office Action Summary Bage. The Examiner has used the correct numbers in rest of the Office Action.

The amendment to the specification was merely to correct a typographical error and does not constitute new matter.

I. JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Claims 1-49, 65-88, 104-118, and 155-158 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-97, 99-172, and 174 of the Erion et al. patent, U.S. Patent No. 6,312,662. The Examiner says:

2